# REMARKS / ARGUMENTS

This Amendment is submitted in full response to the Final Office Action dated November 2, 2005. A Request for Extension of Time, a Request for Continued Examination, and a check for the corresponding fees are filed concurrently herewith, thus, in view of the present Amendments, Remarks, and Exhibit A attached hereto, reconsideration of this application is hereby respectfully requested.

In the Final Office Action, claims 1-4, 6-11, 16, and 17 stand rejected under 35 U.S.C. §102(e) as anticipated by Joseph (U.S. Patent Application Publication No. 2005/0165661). Additional claims stand rejected as unpatentable under 35 U.S.C. §103(a), specifically, claims 12 and 13 stand rejected a over Joseph in view of Murphy el al. (U.S. Patent Application Publication No. 2002/0052778); claim 14 stands rejected over Joseph in view of Pecone (U.S. Patent No. 5,513,329); claim 15 stands rejected over Joseph in view of DeWolf (U.S. Patent Application Publication No. 2002/0032626); and, claim 5 stands rejected over Joseph in view of official notice.

# I. Claim Rejections Under 35 U.S.C. §102 and §103.

Before addressing the substantive issues with regard to the rejection of the claims, Applicant respectfully points out the well established requirement that:

[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. <u>Diversitech Corp. v. Century Steps</u>, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

Moreover, this burden on the U.S. Patent and Trademark Office ("PTO") is further compounded by the fact that the Federal Circuit has stated that within the single reference:

[t]he identical invention must be shown in as complete detail as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

More recently, the Federal Circuit has further expanded this principle to include that:

[a]n anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPO2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed element is not present or is not identically disclosed in as complete detail in a prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 have been overcome.

In addition, for a non-provisional utility patent application to be afforded the priority date of a previously filed provisional patent application under 35 U.S.C. §119(e)(1), "the written description of the provisional must adequately support the claims of

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the non-provisional application." New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294, 63 USPQ2d 1843 (Fed. Cir. 2002).

In other words:

the specification of the provisional patent application must "contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms," 35 U.S.C. § 112 P 1, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. Id.

Furthermore, once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO <u>cannot</u> merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the Federal Circuit instructs that:

[i]n proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facia case of obviousness based upon the prior art [and further that] the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Federal Circuit emphasized this point, stating that:

[t]o prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness. In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

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This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. <u>Beckson Marine</u>, <u>Inc. v. NFM</u>, <u>Inc.</u>, 292 F.3d 718, 63 USPQ2d 1031, 1037 (Fed. Cir. 2002); citing <u>In re Rouffet</u>, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In view of the foregoing, the Applicant respectfully traverses the claim rejections based upon 35 U.S.C. §102 and 35 U.S.C. §103, and requests reconsideration of the same.

To begin, as previously indicated, claims 1-4, 6-11, 16 and 17 stand rejected based solely upon U.S. Patent Application Publication No. 2005/0165661 to Joseph, filed on March 25, 2005 ("the Joseph Publication"), which is a continuation of U.S. Patent Application Serial No. 09/775,002, filed on February 1, 2001, now U.S. Patent No. 6,965,874 ("the Joseph Patent"), which claims the benefit of U.S. Provisional Patent Application Serial No. 60/180,2649, filed on February 4, 2000("the Joseph Provisional Application").

Applicant notes that the sole basis for the rejection of independent claim 1 is that it is anticipated under 35 U.S.C. § 102(e) by the Joseph Publication. Specifically, the Final Office Action states that the Joseph Publication teaches a method, apparatus and program for facilitating transfer of vehicle leases comprising:

means for receiving used leased vehicle and existing lease agreement information submitted electronically by or on behalf of said current lessee and storing said information Application No. 09/943,576 Amdt. Dated: May 2, 2006 Reply to Final Office Action dated November 2, 2005

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in a searchable database ([0042], [0043], [0046], Fig. 6 (102));

means for providing said used leased vehicle and existing lease agreement information electronically to prospective new lessees in response to electronic queries to said searchable database submitted by or on behalf of said prospective new lessees [0030];

means for said prospective new lessees to receive vehicle selection information submitted electronically by or on behalf of said current lessees ([0010], [0049], Fig. 5 (154));

means for notifying electronically said current lesses whose used leased vehicles are selected by prospective new lessees of said selection so that the parties can negotiate and complete a leased vehicle transfer transaction (Fig. 5 (144));

means for receiving and processing insurance application information submitted electronically by or on behalf of said current lessees or prospective new lessees with respect to vehicles selected by said prospective new lessees for insurance covering the current lessee's liability under the existing lease agreement for said vehicle in the event of lease default by the prospective new lessee after transfer of said vehicle and assignment of said lease agreement to said new lessee ([0047], Fig. 7 (244));

means for submitting said insurance application information to one or more insurers for application processing and approval [0050]; and

means for arranging for vehicle and lease transfer and insurance document delivery, payment and vehicle delivery (Fig. 8 (292), "vehicle marked sold" would be inherent delivery).

Applicant respectfully submits that the disclosures of paragraphs [0010], [0042], [0043], [0046], [0047], [0049], and [0050]

of the Joseph Publication are not present in the Joseph Provisional Patent Application<sup>1</sup>, and as such, the Joseph Publication is <u>not</u> entitled to the benefit of the earlier filing date of the Joseph Provisional Patent Application for subject matter not disclosed therein. In addition, Applicant submits that Figures 5 through 8 of the Joseph Publication, are not present in the Joseph Provisional Patent Application and, once again, the later filed Joseph Publication is <u>not</u> entitled to rely on the earlier filing date of the Joseph Provisional Application for subject matter not disclosed therein.

In fact, the above-referenced disclosure relied upon by the PTO was not presented by Joseph until February 1, 2001, when the non-provisional patent application which eventually led to the Joseph Patent, U.S. Patent No. 6,965,874, was filed. As such, the PTO may not rely upon the filing date of the Joseph Provisional Patent Application to support its rejection of independent claim 1 under 35 U.S.C. §102(e) as anticipated by the Joseph Publication.

At best, the PTO may rely upon the filing date of the application which led to the Joseph Patent, i.e., February 1, 2001, however, Applicant's U.S. Provisional Patent Application, which fully

Attached hereto as Exhibit A is a copy of U.S. Provisional Patent Application 60/180,264, as filed on behalf of Joseph on February 4, 2000, which Applicant obtained via a commercial service and believes to be a true and accurate copy, however, the Examiner is invited and encouraged to verify the same.

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discloses the invention as claimed herein and to which a claim of priority is made in the present application, was filed first, on August 20, 2000, and as such, the Joseph Patent does not comprise prior art with respect to disclosure first presented therein.

Notwithstanding the above, and with regard to the basis for rejection of the last element of independent claim 1, namely, "means for arranging for vehicle and lease transfer and insurance document delivery, payment and vehicle delivery", the Office Action states that "vehicle marked sold" would be "inherent" delivery. Applicant respectfully submits that "vehicle marked sold" does not constitute delivery of the used leased vehicle, "inherent" or otherwise. More in particular, the Joseph Publication merely provides, at paragraph [0050], that:

[a]t step 292 the vehicle record is marked sold in the vehicle lease database so that future searching users will not unnecessarily waste their time by expressing interest in a vehicle which is no longer available.

Thus, "vehicle marked sold" as indicated at 292 in Figure 8 of the Joseph Publication, bears no relationship to the delivery of a used leased vehicle, rather, marking a vehicle record as "sold" solely serves to notify users that the vehicle so marked is no longer available. Conversely, Applicant discloses coordinating a time and place for the parties to inspect and transfer the vehicle and, if

necessary to coordinate with inspection and transportation companies as necessary (see Paragraph 85).

Accordingly, it is believed that independent claim 1 as recited herein is in condition for immediate allowance and, therefore, dependent claims 2 through 16 which depend therefrom, either directly or indirectly, are also believed to be in condition for immediate allowance.

Furthermore, independent claim 17 stands rejected "on the same rationale as set forth above in Claim 1," and since the bases for rejection of independent claim 1 have been overcome, the rejection of independent claim 17 has also been overcome. Accordingly, independent claim 17 is also believed to be in condition for immediate allowance.

Thus, the Applicant has established that at least one claimed element is not present or is not identically disclosed in as complete detail by the Joseph Publication. Specifically, Applicant respectfully submits that the PTO cannot rely upon the claim of priority to the earlier filing date of the Joseph Provisional Application in the Joseph Publication for subject matter not disclosed in the prior filed application, and as a result, the Joseph Publication is insufficient to support the present claim rejections under 35 U.S.C. §102, and, the rejections are overcome. Further, in

view of the foregoing, the Applicant respectfully submits that the grounds for rejection under 35 U.S.C. §103 based upon the Joseph Publication in view of Murphy, Pecone, DeWolf, and official notice, are also insufficient, and are overcome.

Therefore, the Applicant maintains that independent claims 1 and 17, as previously presented, are in condition for immediate allowance, and reconsideration by the Examiner is respectfully requested. Further, each of the claims depending from independent claim 1, either directly or indirectly, are now also in condition for immediate allowance.

# II. New Claim 18.

Applicant further submits that new independent claim 18 is also in condition for immediate allowance. More in particular, new independent claim 18 recites a method for transferring a used leased vehicle comprising the steps of notifying a prospective new lessee of leased vehicle and leased term data which matches the perspective lessees' preferences as stored in a wish list, which are <u>not</u> disclosed or suggested in the cited references. As such, newly presented independent claim 18 is also believed to be in condition for immediate allowance. Applicant further submits that new independent claim 18 is fully supported by the disclosure of the specification of the

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present application and contains no new subject matter.

Accordingly, based on the foregoing Amendments, Remarks, and Exhibit A attached hereto, the Examiner is respectfully requested to reconsider the present application. Since nowhere in the art is this new, novel and non-obvious invention found, taught, or suggested, it is urged that this case is now clearly in condition for allowance and, accordingly, such action is respectfully solicited.

In the event that any additional fees may be required by the filing of this paper, an Authorization to Charge Fees to Deposit Account, Deposit Account No. 13-1227, is being filed concurrently with this Amendment.

Respectfully Submitted,

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John Fulton, (r) Reg. No. 46,716

Date: 5-2-0

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### PATENT

# METHOD FOR ASSIGNING AUTOMOBILE LEASES

### BACKGROUND OF INVENTION

The present invention relates to methods for facilitating transferring automotive vehicle 5 leases from a lessee of a vehicle lease to a new lessee and, more particularly, methods of transferring vehicle leases in which the relevant information is accessible over the Internet. The method of the present invention is set forth in the accompanying Figures 1-3, which are briefly described as follows:

- Fig. 1 is a schematic flow chart showing a preferred embodiment of the method 1. of the invention;
- Fig. 2 is a schematic flow chart showing an aspect of the method of a preferred 2. embodiment of the present invention in which a stored vehicle lease record is modified or deleted; and
- Fig. 3 is a schematic flow chart showing optional aspects a preferred embodiment 3. of the method of the present invention, namely, connections between the Internet Website at which lease records are displayed and other sites where information concerning vehicle purchasing and vehicle insurance are displayed.

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#### SUMMARY OF THE INVENTION

The present invention is a method and system for assigning automotive vehicle leases in which individuals owning a leased automotive vehicle who wish to assign the lease can be sought out by individuals who wish to assume the lease for that vehicle. Preferably, this system is implemented by use of an interactive Internet Website. An individual having a vehicle lease or leases he or she intends to assign contacts the Website and is given an access code and password. Under that access code and password, the lease owner can enter data to create one or more records pertaining to one or more vehicles whose leases are to be assigned. The records not only include information pertaining to the leased vehicle, but include information enabling a potential assignee of a vehicle lease (the "lease buyer") to contact the lease owner. The records created by the lease owner are placed within a database and all of the records can be displayed, or a subset of all the records can be displayed, the subset being determined by features desirable by the viewer, such as type of vehicle, age of the vehicle, location of the vehicle, and the like.

An individual who intends to assume a lease will also access the Website, and there can view all vehicle leases and vehicle profile records, or a desired subset. The lease assignee also can obtain contact information, and from there, can contact a lease owner to negotiate a lease transfer.

In a preferred embodiment of the invention, the site also enables a potential lease assignee to download a credit application pertaining to the bank/vehicle owner, and such an operation can be performed either before contacting the potential lease assignee, or subsequent to such contact.

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# DETAILED DESCRIPTION

The method of the invention is described in greater detail as follows, with reference to the accompanying drawings and exhibits. As shown in Fig. 1, an individual, such as a lease owner, who intends to assign a vehicle lease first accesses the home page 10 of the Website, which appears as Exhibit A. At this home page 10, the individual is introduced to the Website and is presented with buttons which activate links which are selectively activated depending on whether he or she intends to assume a vehicle lease ("I WANT TO LEASE"), sell a vehicle lease ("I WANT TO SELL MY LEASE") or, if the individual has already visited the site and registered to sign in and view his or her account. If the individual is a first-time visitor the individual so indicates by clicking on the icon on the home page 10 and is directed to a page 12 which displays the rules (Exhibit B). After reading the rules, which optionally can be displayed at 14, the lease owner is sent to a screen 16 at which the lease owner creates an account by entering a user identification code ("user ID") and password (Exhibit C).

The lease owner then reenters his or her own ID and password and logs on, as shown in block 18 in Fig. 1 (Exhibit D). Once having logged in, the lease owner is directed to a Main Menu 20 which provides options which include adding a new vehicle lease, modifying an existing vehicle lease, deleting an existing vehicle lease, listing all of the leases entered by that lease owner, or searching for a particular vehicle lease in a search database (Exhibit E).

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If the lease owner intends to add a lease, he or she is directed to a screen (Exhibit F) at block 22 at which the lease owner is prompted to enter information pertinent to the leased vehicle and lease to be assigned. Once the information has been entered, the newly created record is displayed as indicated in block 24 and Exhibit G. At this point, as indicated as block 26, the lease record is entered into the search database.

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As shown in Fig. 2, if the lease owner wishes to modify a lease, from the Main Menu shown at block 20, the lease owner is linked to a "Modify Records" indicated at block 30 and shown as Exhibit H. Screen 30 lists all of the lease records created by that lease owner and entered into the database, and prompts the lease owner to select a particular lease to be modified, as shown in Exhibit I. The user selects a particular lease by mouse-clicking on the appropriate record, and is linked to a screen, represented by block 32, which displays the record to be modified (see Exhibit I).

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At that point, the lease owner modifies the data in the field or fields of the record as desired and indicates approval of the modified record by clicking on an appropriate button. As indicated at block 34, the modified record is displayed and entered into the database, replacing the original record. The lease owner is then sent back to the home page 10.

In the alternative, if the lease owner intends to delete a lease, that option is selected in the Main Menu block 20 (Exhibit E) and the lease owner is linked to a screen, represented by block 36, which displays all of the lease records entered by the lease owner. The lease owner then indicates by a mouse click which lease or leases are to be deleted (see Exhibit K), and mouse clicks on a button to delete the record or records marked for deletion. The lease owner is then linked to a screen, indicated at block 38, which indicates that the selected lease records have been deleted, shown as Exhibit L. The lease owner is than given the option of returning to the home page 10, or in the alternative, adding a lease, deleting a lease, modifying a lease, listing all leases, or viewing the Main Menu.

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Referring back to Fig. 1, if an individual accessing the home page 10 intends to assume (or "buy") a lease, as shown in Exhibit A, the appropriate virtual button ("I WANT TO LEASE") is activated and the lease buyer is directed to a "Search Database" screen, represented by block 40 and shown as Exhibit M. It should be noted that the screen indicated at block 40 and illustrated

in Exhibit M can be accessed from a number of locations at the Website, including the Main Menu 20.

From the Search Database 40 the lease buyer can select either to view all vehicles in the database, and be linked to "Displaying All Vehicles" at block 42, or can submit certain parameters, including the city and state of the residence of the owner of the vehicle; the make, model, year, color and number of doors on the vehicle; and/or the amount of the monthly payment of the lease. Such criteria are shown in Exhibit M. Once such information is communicated to the system, which occurs when the lease buyer clicks a button labeled "View Vehicles" the lease buyer is linked to a "Display Selected Vehicles" screen 44 which displays all of the vehicles meeting the selected criteria, shown as Exhibit N (this screen is similar to the "Display All Vehicles" screen 42, except that the latter screen includes a listing of all vehicles in the database).

From the screen illustrated as Exhibit N (and shown schematically in Fig. 1 as blocks 42, 44) the lease buyer selects a particular vehicle and is instructed to click on the year date of the vehicle, which will pull up a "Display Vehicle Profile" screen 46, shown as Exhibit O, which displays all of the information pertaining to that vehicle. The lease buyer is then provided with the option of calling up a screen, shown as Exhibit P, which displays the directions pertaining to assuming the lease, shown as block 48.

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At this point, the lease buyer has the option of downloading a credit application, shown at block 50, filling out the credit application and sending it to the lessor bank, indicated at block 52. Since, at the present time, banks generally accept only credit applications with original signatures, the transmission of a completed credit application from a lease buyer to a bank is performed offline, with the actual lease document. However, it is within the scope of the invention to provide a system in which a completed credit application is transmitted

electronically to a bank with appropriate signature verification protocols. The final step with respect to the assignment of the lease from the lease owner to the lease buyer, is to receive the signed credit application and lease transfer documentation from the bank, shown at block 54.

At any point along this procedure, that is, from blocks 46 through 54, the lease buyer contacts the lease seller, shown as block 56. At this point, the lease buyer can contact the lease seller through information displayed on the screen 46, shown as Exhibit O, in which the lease seller may provide an e-mail address, telephone number, mail address and so on. Once the lease buyer has contacted the lease seller, the parties can negotiate offline (meaning not through use of the subject Website) with respect to the terms of the lease assumption. These terms would include the payment, if any, to be exchanged between the lease buyer and the lease seller to compensate for, for example, a security deposit or a capital reduction payment. Of course, it is within the scope of the invention to provide a system in which payment can be made by a lease seller to a lease buyer in order to make the assumption of the lease more attractive.

While it is likely that the lease seller will be contacted by a potential lease buyer prior to the lease buyer downloading a credit application (block 50), it is within the scope of the invention to provide a system in which the lease buyer can obtain the credit information first, to verify that the lease buyer could qualify to assume a lease having a particular monthly payment amount.

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As shown in Fig. 3, the method of the present invention provides additional capabilities. For example, from the Home page, an individual who decides against assuming a lease, can be linked to a site, represented by block 58, vehicles are listed for purchase, rather than for lease assumption. In addition, an individual at the Home page 10 can be linked to a site, represented by block 60, at which information pertaining to insurance quotes can be viewed.

Accordingly, the foregoing sets forth an efficient and automated mechanism to enable automobile vehicle leases to be assigned from leaseholders to lease buyers through use of an Internet Website which is accessible by the public at large.

#### INVENTION

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A method for assigning automobile leases includes the steps of:

providing a website which displays a menu giving a visitor an option of either creating a record including details of the visitor and of a leased automobile whose lease the visitor intends to assign, or viewing a list of records, each record including a description of a leased automobile and an owner thereof;

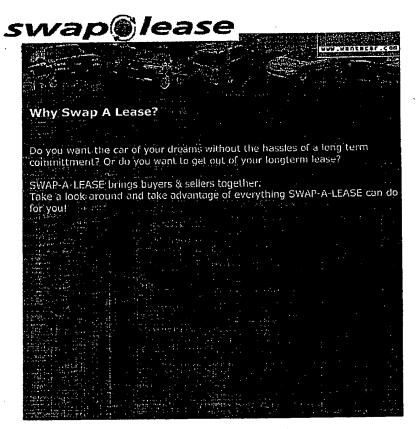
if the visitor intends to create a record, directing the visitor to a page at the website where the visitor can input information pertaining to a leased automobile and information to enable another visitor to the website to contact the visitor;

storing the record created by the visitor in a database; and

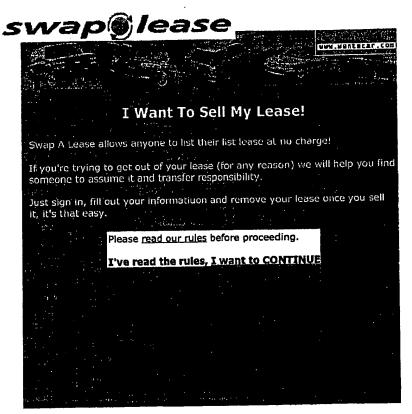
if the visitor intends to view a record or records, directing the visitor to a page at the website where the visitor can view at least one record of a leased automobile.

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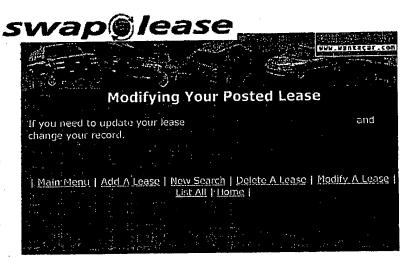
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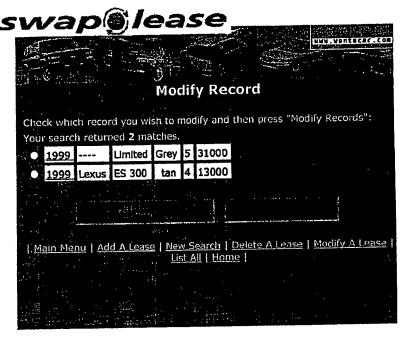
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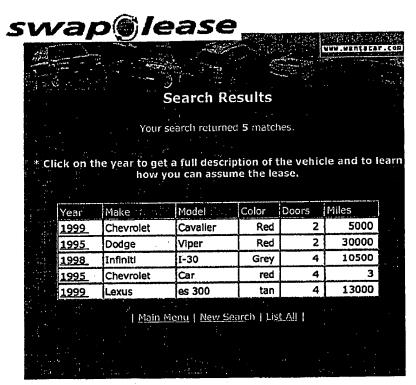
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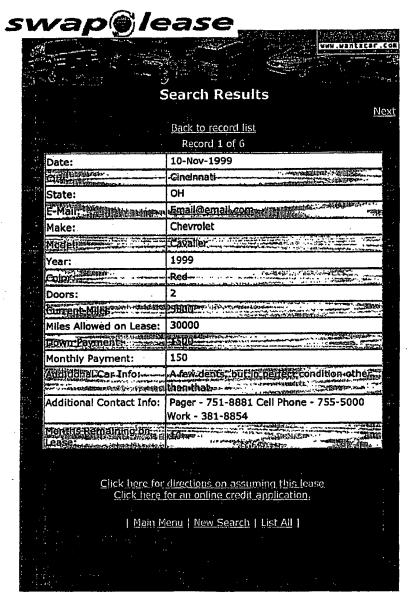
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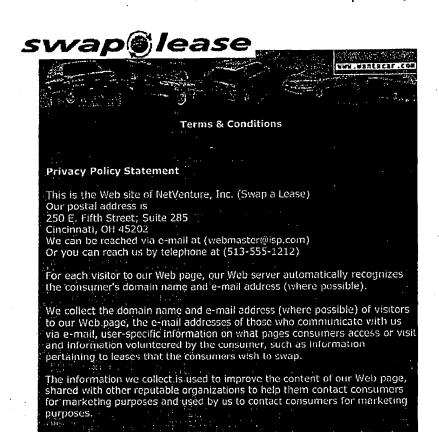
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I Want to Lease - I Want to Sell My Lease





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Persons who supply us with their telephone numbers Online may receive

telephone contact from us with information regarding new products and services or upcoming events. If you do not wish to receive such telephone calls, please let us know by sending email to us at the above address. They also may receive telephone contact from other reputable companies. You can, however, have your name put on our do-not-share list be sending email to us at the above address. Please provide us with your correct phone number. We will be sure your name is removed from the list we share with other organizations.

I've read the rules.

# Directions on assuming the lease

Follow the instructions on this page and you can take over the leased vehicle you desire - It's easy to do and fun.

- 1. Contact the current lessee to discuss the vehicle and the lease details.
- Contact the current lessee to discuss the vehicle and the lease details.
   Contact the lessee's bank representative.
   They will supply you with a credit application to be filled out and faxed or e-mailed back to them.
   The bank will review the application and the Swap for approval \*.
   The bank processes the paper work and mail you mail back the signed
- contract. (Keep a copy for your records.)
  6. The vehicle is now yours for the remaining term of the lease.
  7. Go to the Bureau of Motor vehicles to get your tags.

- 8. Enjoy the vehicle You made a smart decision.
- \* Nothing changes on the original lease contract except the name of the person assuming the lease...

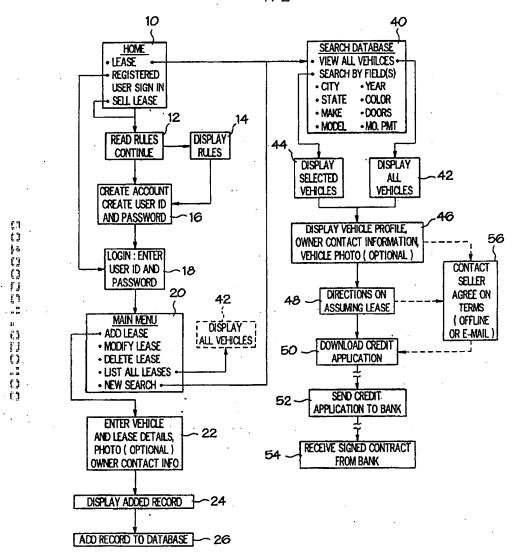
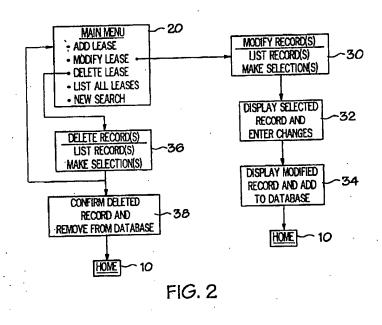


FIG. 1



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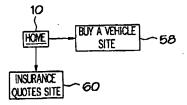


FIG. 3

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